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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,146	05/16/2005	Dominique Conte	0579-1090	2394

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YOUNG & THOMPSON
209 Madison Street
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EXAMINER

WIECZOREK, MICHAEL P

ART UNIT	PAPER NUMBER
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1712

NOTIFICATION DATE	DELIVERY MODE
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10/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/535,146	Applicant(s) CONTE ET AL.	
	Examiner Michael Wieczorek	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) 3,6,10,12,13,18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-9,11,14-16,19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. In view of the appeal brief filed on July 9, 2010, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Timothy H Meeks/

Supervisory Patent Examiner, Art Unit 1715.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1, 2, 4, 5, 7-9, 11, 14-16, 19 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 is vague and indefinite because it is not clear if the temporary adhesion enhancing layer is present during the marking operation using an energizing source. Claim 1 only discloses that during some point of the claimed method that there is deposited onto the outermost layer the temporary adhesion enhancing layer and that it has a thickness of less than about 5 nm for the purposes of enabling the energizing source to act on the outermost layer through the temporary layer. The limitation that the temporary layer has a thickness which allows the energizing source to act through it is not the same as a limitation disclosing that the temporary layer is present during marking as is disclosed within claim 25. For the purposes of this examination, claim 1 is being treated as there being present the temporary adhesion enhancing layer on the outermost surface during the claimed energizing source marking operation but there is no specific limitation within the claim that the temporary layer has to or is present during the marking operation. Clarification on this issue is requested.

5. Claim 1 recites the limitation "the required mark" in the fifth line and the limitation "underlying high energy coating" in the eighth line of the claim. There is insufficient antecedent basis for these limitations in the claim.

6. Claim 25 recites the limitation "the desired mark" in the fifth line and the limitation "underlying high energy coating" in the eighth line of the claim. There is insufficient antecedent basis for these limitations in the claim.

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7. The terms "low surface energy" and "high surface energy" in claims 1 and 25 are relative terms which renders the claim indefinite. These terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Because of these terms it is not clear how much surface energy the outermost layer or the surface coating possess.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-5, 7-11, 14-16, 19, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacan et al (U.S. Patent Publication No. 2003/0049370) in view of Souel et al (U.S. Patent # 6,281,468).

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Lacan teaches a wherein a temporary protective layer is applied on a hydrophobic and/or oil-repellant coating of an ophthalmic glass for the purposes of enhancing adhesion during trimming and provide protection to the glass surface during handling (Page 1 Paragraphs 0021-0025). Lacan further teaches that the outermost hydrophobic and/or oil-repellant surface coating has a low surface energy and the temporary protective coating has a higher surface energy than the low energy surface coating (Page 2 Paragraph 0036-0037).

Lacan further teaches that the protective coating has a thickness of from 1 to 50 nm (Page 2 Paragraph 0056) thus Lacan teaches a thickness range which overlaps the claimed of less than 5 nm. Overlapping ranges are prima facie evidence of obviousness. It would have been obvious to one having ordinary skill in the art to have selected the portion of Lacan's protective layer thickness range that corresponds to the claimed range. *In re Malagari*, 182 USPQ 549 (CCPA 1974).

Lacan does not teach the marking method wherein a mask having a configuration complimentary to the required mark is positioned between the face of the lens to be marked and an energizing source adapted to eliminate selectively the outermost layer in order to reveal the substrate or underlying high energy coating but Lacan does teach that the glass comprising the temporary protective layer may be subjected to a marking operation as known in the art (Page 3 Paragraph 0087).

Souel teaches a method of marking the face of an ophthalmic lens (Column 1 Lines 6-10) wherein a low surface energy hydrophobic layer has been deposited over a high surface energy coating or the lens substrate (Column 3 Lines 7-25). The taught method involves positioning a mask having a configuration complementary to a required mark between the face of the lens to

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be marked and energizing discharge source in the form of a corona discharge (Column 2 Lines 7-24 and 46-50) and the source eliminates substantially the outermost low surface energy layer in order to reveal the substrate or underlying coating (Column 3 Lines 39-46).

At the time the present invention was made it would have been obvious to one having ordinary skill in the art to have marked the surface of the lens through a mask using an energizing source. Based on the teaching of Lacan and Souel, one of ordinary skill in the art would have a reasonable expectation of success in performing the marking method of Souel on the temporary coated ophthalmic lens of Lacan since the marking method of Souel is a known and conventionally used marking operation in the art.

As for claim 2, as was discussed above, the temporary layer of Lacan has a thickness range of 1 to 50 nm which overlaps with the claimed range or less than 5 nm which encompasses the range of 2 to 4 nm.

As for claims 3 through 5, Lacan teaches that the temporary protective layer is a mineral layer comprised of MgF_2 , LaF_3 , AlF_3 and CeF_3 (Page 2 Paragraphs 0049-0050).

As for claim 7, Lacan teaches that the temporary protective layer is deposited by evaporation (Page 2 Paragraph 0055).

As for claim 8, the temporary protective layer of Lacan is deposited on a region of the glass face intended to be in contact with the glass retaining when trimming (Page 2 Paragraph 0038).

As for claims 9 and 10, the temporary protective layer of Lacan has either a substantially continuous structure or a discontinuous structure (Page 2 Paragraph 0040).

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As for claim 11, Lacan teaches that the temporary protective layer takes the form of a screen (Page 5 Claim 8).

As for claims 14 and 15, Lacan teaches that the hydrophobic and/or oil-repellent coating comprises fluorinated groups and is applied onto an antireflection coating (Page 2 Paragraphs 0029-0034).

As for claim 16, the top coat includes a plurality of layers (Pages 1-2 and Paragraphs 0028-0029).

As for claims 19 and 21, Lacan teaches that the temporary protective layer is removed by dry wiping and after removal there is a cleaning step using an aqueous solution with a pH substantially equal to 7 (Page 3 Paragraph 0081).

In the case of claim 25, it is rejected for the same reasons as were discussed above in the claim 1 rejection, furthermore Lacan teaches removing the temporary protective layer after trimming of the lens (Page 3 Paragraphs 0066-0072).

11. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacan et al in view of Souel et al as applied to claim 1 above, and further in view of Kimock et al (U.S. Patent # 5,190,807).

The teachings of Lacan in view of Souel as they apply to claim 1 have been discussed previously. Lacan teaches that prior to the deposition of the hydrophobic and/or oil-repellant coating one or more mineral or organic layers in the form of a anti-abrasion coating and anti-reflections coatings are deposited in that order on to the entire surface of the glass substrate (Page 3 Paragraphs 0089-0094). But neither Lacan nor Souel teach treating the surface of the

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lens by energetic and/or reactive substance capable of attacking and/or chemically modifying the surface prior to depositing a mineral or organic layer.

Kimock et al teaches a method for improving the adhesion of a hard coating to a optically transparent polymeric substrate by first treating the surface of the substrate with a reactive substance in the form of an adhesion-mediating polysiloxane polymer to chemically modify the surface of the substrate before depositing the hard coating (Column 4 Lines 48-68 and Column 5 Lines 1-17).

At the time the present invention was made it would have been obvious to one of ordinary skill in the art to treat the surfaces of a lens with a reactive substance to chemically modify the surface prior to deposition of one or more mineral or organic layers and a hydrophobic and/or oleophobic outermost layer. It would have been obvious to treat the surfaces of the glass substrate of Lacan by the method of Kimock et al prior to the deposition of the hard coating/anti-abrasion coating in order to improve the adhesion between the hard coat and the lens substrate.

As for the limitations of claims 22 and 23 wherein the first face is treated and then flipped over treat the second face, since the anti-abrasion coating is being applied to the entirety of the substrate surface it would have been apparent to one of ordinary skill in the art to perform the adhesion enhancing step Kimoch on both faces of the glass substrate of Lacan prior to depositing the anti-abrasion and anti-reflection layers.

Furthermore, in general, the transposition of process steps or the splitting of one step into two, where the processes are substantially identical or equivalent in terms of function, manner result was held to not patentably distinguish the process. *Ex parte Rubin*, 128 USPQ 440 (Bd.

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Pat. App. 1959). Thus since the method of Lacan in view of Souel and Kimoch are substantially equivalent in terms of function, manner and result to that of the claims, the claims are not patentably distinguishable from those taught by the references.

As for claim 24, Lacan teaches that the temporary protective layer is applied to one or both faces of the glass substrate (Page 2 Paragraphs 0037-0038).

12. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Conclusion

Claims 1, 2, 4, 5, 7 through 9, 11, 14 through 16, 19 and 21 through 25 have been rejected. Claims 3, 6, 10, 12, 13 and 18 have been withdrawn from consideration as being non-elected species. No claims were allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Wiczorek whose telephone number is (571)270-5341. The examiner can normally be reached on Monday through Friday; 6:00 AM to 3:30 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on (571)272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frederick J. Parker/
Primary Examiner, Art Unit 1715

/Michael Wieczorek/
Examiner, Art Unit 1712